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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,816	02/05/2002	Nobuo Shiraishi	81833.0031	1572

26021 7590 09/08/2003

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EXAMINER

HUYNH, LOUIS K

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 09/08/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/980,816

Examiner

Louis K. Huynh

Applicant(s)

SHIRAISHI ET AL.

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4,6 and 8-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-3,8-15 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4,6 and 16-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of Group II, claims 4, 6 and 16-20 in Paper No. 8 is acknowledged.
2. Claims 1-3,8-15 and 21 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 8.

### *Specification*

3. The disclosure is objected to because of the following informalities:  
  
"sampler is includes" (page 1, line 21) should be changed to: --sampler includes--;  
  
Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 4, 6 and 16-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 is indefinite for being incomplete. The step of adhering lamination material to the upper surface of mount cannot be performed without first clearing and/or cleaning the upper surface from the cosmetic powder that covers the upper surface of mount by the filling step which fills the powdery cosmetic material on the upper surface of the mount.

Claim 4, lines 7-9: “adhering lamination ...mount and the pressed ... adhering layer” is confusing. Perhaps, a comma or a semi-colon should be inserted between “...the mount” and “and the pressed powdery...”

Claim 4, line 10: cutting the mount to obtain a cut piece as a cosmetic material sheet” is vague and indefinite for it is unclear as to formation of the cutting. Perhaps, “cutting the mount between the plurality of concave portions to obtain a cut piece as a cosmetic material sheet” would provide proper structural relationship between the claimed method steps.

Claim 6 appears to be incomplete for lacking an essential structural limitation of a means for cleaning the upper surface of the mount after the upper surface of the mount has been filled with powdery cosmetic material. Since the filling device fills the entire upper surface of the mount with powdery cosmetic material; therefore, the lamination material cannot be adhered to the upper surface of the mount without the means for cleaning the upper surface of the mount.

Claim 6, lines 7-8: “a laminating device which adheres lamination material to the upper surface of the mount and the pressed powdery cosmetic material” is confusing for it is unclear whether or not the laminating device actually adheres the lamination material to the pressed powdery cosmetic material.

Claim 16, line 2: “forming a vapor-deposition layer on the upper surface” lacks proper antecedent basis in the specification. The specification discloses an aluminum vapor-deposition layer formed on the upper surface of the plate-like frame, but does not disclose a vapor-deposition being formed on the upper surface of the mount that has a plurality of concave portions formed thereon.

Claim 17, line 2: “printing a product number on the upper surface” lacks proper antecedent basis in the specification. The specification discloses printing of product number on the upper surface of the plate-like frame, but does not disclose printing of product number on the upper surface of the mount that has a plurality of concave portions formed thereon.

Claim 18, line 2: “a frame portion” renders the claim indefinite for it is unclear as to what frame portion applicant is referring.

Claim 19, line 2: “the fame portion” lacks proper antecedent basis. Furthermore, it is unclear as to what fame portion applicant is referring.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Vaughn (US 2,365,920).

With respect to claim 4, Vaughn discloses a method for producing cosmetic powder puffs including the steps of: supplying a mount (31) having a plurality of concave portions (62) formed on the upper surface of the mount; filling powdery cosmetic material (60) onto the plurality of concave portions; pressing the filled powdery cosmetic material; adhering a lamination material (80) to the upper surface of the mount (31); and cutting the mount through the lamination material around the each of the plurality of concave portions (page 3, left column, line 6 – page 3, right column, line 73).

With respect to claim 6, Vaughn discloses an apparatus for producing a cosmetic powdery puffs including: a supplying device (63) for forming a plurality of concave portions (62) on a mount (31); a filling device (43) for filling powdery cosmetic material (60) onto the plurality of concave portions (62); a pressing device (71) for compacting the filled powdery cosmetic material; a laminating device (90) for adhering a lamination material (80) to the upper surface of the mount; and an inherent cutting device for cutting the mount through the lamination material around the each of the plurality of concave portions (page 3, right column, lines 38-45).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4, 6 and 17-20, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Berman et al. (US 5,953,885) in view of Gueret (US 4,962,627).

With respect to claims 4 and 6, Berman discloses a method and an apparatus for making cosmetic sampler including: a supply device (Figure 5) for supplying a mount (68), wherein the mount (68) has a plurality of concave portion (66') formed on the upper surface of the mount (68); a filling device (48) for filling genuine cosmetic samples (51) on the upper surface of the mount (68) in the areas of the plurality of concave portions; a lamination device (32) for adhering lamination material (62) to a plate-like frame (64); and a cutting device (54) for cutting the mount to obtain a cut piece (71) as a cosmetic material sampler sheet. The method of Berman meets all of applicant's claimed subject matter but lacks the specific teaching of the

sample being cosmetic powdery material and the filled cosmetic powdery material being pressed by a pressing device.

However, Gueret discloses a method for producing cosmetic compact products from cosmetic powdery material wherein a quantity of cosmetic powdery material is pressed to form a compact product prior to being packaged.

Therefore, it would have been obvious to a person with an ordinary skill in the art, at the time the invention was made, to have modified the method of Berman by having provided cosmetic powdery material and a pressing device for pressing the filled powdery cosmetic material, as taught by Gueret, in order to form a cosmetic sampler comprising cosmetic powdery material in a compact form.

With respect to claim 17, as best understood, the method of Berman includes printing stations (26 & 30) for printing advertising or other desired material on either side of the lamination material (62) but does not specifically disclose printing product number on the upper surface of the mount. However, it would have been obvious to a person with an ordinary skill in the art, at the time the invention was made, to have modified the method of Berman by having provided a printing device for printing a product number on the upper surface of the mount since printing product information is well known in the art.

With respect to claim 18, the plate-like frame (64) in the modified method of Berman is formed with a window (66') (column 6, lines 48-54).

With respect to claim 19, the height of the plate-like frame would have been higher than the pressed cosmetic powdery material in the modified method of Berman.

With respect to claim 20, the lamination material is adhered to the plate-like frame with peelable glue in the modified method of Berman (column 6, lines 54-60).

10. Claim 16, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Berman et al. (US 5,953,885) in view of Gueret (US 4,962,627) as applied to claim 4 above; and further in view of Misiano et al. (US 5,704,980).

The modified method of Berman meets all of applicant's claimed subject matter but lacks the specific teaching of the step of forming a vapor-deposition layer on the upper surface of the mount.

However, Misiano discloses a method for making plastic film with barrier layers wherein the plastic film is provided with a layer or layers of aluminum by vapor deposition for forming a barrier against gas, vapor, odor and especially water vapor and oxygen on plastic film.

Therefore, it would have been obvious to a person with an ordinary skill in the art, at the time the invention was made, to have further modified the method of Berman by having provided a step of forming an aluminum vapor-deposition layer on the upper surface of the mount, as taught by Misiano, in order to form a barrier against gas, vapor, odor, water vapor and/or oxygen from destroying the powdery cosmetic material.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure has been cited on form PTO-892 along with the applied prior art.



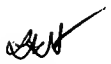

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louis K. Huynh whose telephone number is (703) 306-5694.

The examiner can normally be reached on M-F from 9:30AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on (703) 308-2187. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



Louis K. Huynh  
Patent Examiner  
Art Unit 3721

LH  
September 03, 2003